

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Dany Sylvain  
Serial No. 10/824,662  
Filed: 04/14/2004

Examiner: Zhiyu Lu  
Art Unit: 2618

For: **MOBILE TERMINAL WITH WIRED AND WIRELESS NETWORK  
INTERFACES**

Mail Stop AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

**DECLARATION UNDER 37 C.F.R. § 1.131 OF BENJAMIN S. WITHROW**

1. My name is Benjamin S. Withrow of the law firm of Withrow & Terranova, PLLC, and I am a registered U.S. patent attorney, Registration No. 40,876.
2. Starting in 2000, and continuing until the present time, I have been retained as outside counsel for Nortel Networks, Ltd. ("Nortel"), the assignee of the present application.
3. On or about January 20, 2004, I received instructions from Nortel to prepare and file a patent application for an Invention Disclosure entitled "Handset with wired and wireless network interface," which is attached to this Declaration as Appendix A (hereinafter "Invention Disclosure"). This Invention Disclosure was assigned attorney docket number 7000-339.
4. The Invention Disclosure was submitted by the inventor, Dany Sylvain, on November 9, 2003.
5. Starting on or about January 21, 2004 and continuing through February 25, 2004, I reviewed the Invention Disclosure, discussed the invention with the inventor, Dany Sylvain, and worked to prepare a patent application (hereinafter "Patent Application") claiming the invention disclosed in the Invention Disclosure.

6. On February 26, 2004, a first draft of the Patent Application (hereinafter "First Draft") was sent to the inventor, as evidenced by the e-mail attached to this Declaration as Appendix B.

7. On March 8, 2004, I received changes from the inventor regarding the First Draft, as evidenced by the excerpt from a spreadsheet attached to this declaration as Appendix C.

8. Between March 8, 2004 and March 16, 2004, I revised the Patent Application to incorporate the changes from the inventor for the First Draft, and sent a revised Patent Application to in-house counsel at Nortel, as evidenced by the spreadsheet attached to this declaration as Appendix C.

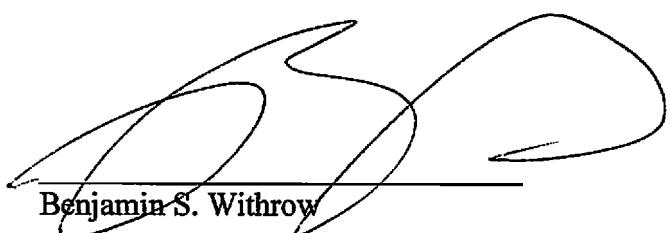
9. On March 17, 2004, a copy of the revised Patent Application and the inventor declaration and assignment document were sent to the inventor to be signed, as evidenced by the spreadsheet attached to this declaration as Appendix C.

10. On March 19, 2004, I received a signed inventor declaration and assignment document from the inventor, as evidenced by the spreadsheet attached to this declaration as Appendix C.

11. On April 14, 2004, I received approval from in-house counsel at Nortel to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on March 16, 2004, as evidenced by the spreadsheet attached to this declaration as Appendix C.

12. On April 14, 2004, the Patent Application was filed at the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/824,662.

13. I hereby declare that all declarations made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Benjamin S. Withrow

June 6, 2007  
Date

# **Appendix A**



1000-221

4006 E. Highway 54  
Dept. N237, MS D16/02/0E2  
Network Center 2  
Durham, North Carolina 27713

[www.nortelnetworks.com](http://www.nortelnetworks.com)

John R. Witcher, III  
Senior Counsel

**NORTEL NETWORKS CONFIDENTIAL &  
PRIVILEGED COMMUNICATION**

January 20, 2004

VIA FEDERAL EXPRESS

Mr. Benjamin Withrow, Esq.  
Withrow & Terranova  
201 Shannon Oaks Circle  
Suite 200  
Cary, NC 27511

**Re:**

**Title: *Handset with Wired and Wireless Network Interface***

Dear Ben:

Nortel Networks would like to retain you to prepare and file in the United States Patent and Trademark Office (USPTO) a patent application directed to the invention disclosed in the enclosed invention disclosure by the above-referenced filing date. The application should be prepared according to Nortel Networks guidelines in accordance with the predetermined fee we have agreed with your firm. If you are unable to perform the requested work, please advise me immediately.

In addition to the invention disclosure, an invention disclosure Review Summary document is enclosed for your consideration. We request that you contact the primary inventor, Dany Sylvain, at [redacted] within two weeks of receiving this letter. Please ensure that the inventor(s) are advised of their responsibilities regarding their duty of candor to the USPTO, as well as any other relevant rules and/or laws including the best mode requirement.

Questions pertaining to substantive issues associated with the application should be addressed with me, while administrative issues associated with the application should be addressed with Theresa Boyce. Please be sure that all communications associated with the application, including billing statements and the application itself bear the above-referenced disclosure number.

Please send a substantially complete and final draft of the application to me along with a completed Nortel Networks Outsource's Patent Application Checklist at least 10 days prior to the above-referenced filing date to provide Nortel Networks' Intellectual Property Law Group sufficient opportunity to review the application prior to filing. You should seek to obtain the signatures on the formal papers from all inventors directly.

Ben Withrow  
January 20, 2004  
Page 2

**Please confirm receipt of this disclosure via facsimile to the above-identified number.  
Please include your assigned reference number.**

Upon filing the application with the USPTO, immediately fax a copy of the application transmittal letter to me, so that we have a record that the application has been filed. Thereafter, please send me a hardcopy of the application as filed along with an electronic copy in Microsoft Word 6.0 readable format on a 3 1/2" floppy disk.

Should you have any questions, please call me at

Very truly yours,



Rick Witcher

Enclosures: Invention Disclosure  
Review Summary  
Patent Application Outsource Checklist

JRW:slw

cc: Dany Sylvain

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NOV - 9 2003

Invention Disclosure Submission Reply

Disc No:	Received Date:	09 nov 2003
Disclosure Title:	Handset with wired and wireless network interface	

===== Inventors =====

Global ID	Name	Work Info	Home Info
	HR Name: SYLVAIN, DANY Known As: DANY Email:  Mgr First Name: STEPHEN Mgr Last Name: ELLIOTT Mgr Global ID:	Location: ;  Location Code: Dept: Phone: Ext Phone: Fax: Ext Fax: MailStop: Citizenship: CANADA	Address:  Phone:

===== Attachments =====

<End of Attachments>

Were there additional inventors involved?	no	Was there contractor involvement?	no
Name of Supervisor, Director, Lead:	STEVE ELLIOTT	Name of VEs:	SUE SPRADLEY
LOB:	WIRELINE NETWORKS**	Business Unit:	CTL/VOIP
Conception Date:	Has this invention been discussed with others? If so, please complete.		
Inside Nortel - Whom:	Outside Nortel - Whom:		
Inside Nortel - When:	Outside Nortel - When:		
NDA: no			
Are you aware of any imminent or future disclosures? Please provide dates and details.			
Keywords for Searching:		Products that will use this invention:	

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dual mode handset, WLAN, Bluetooth, cellular, mobile, LAN, Ethernet, SIP, SDP	MCS, Succession
<p>Does this invention arise from any arrangement involving an external organization? <input type="checkbox"/> no</p> <p>Is this invention relevant to a Standards Activity? <input type="checkbox"/> Internal Funding Project? <input type="checkbox"/></p> <p><b>no</b></p> <p style="text-align: center;"><b>Provide details:</b></p> <p> </p>	

## Technical Information

**THE DEATH OF THE INVENTION:**

A mobile handset supporting at least two communication interfaces:

- WLAN (or Bluetooth or any other technique using unlicensed spectrum)
- LAN (for wired communication)
- (optionally, it also supports a cellular interface)

A docking station compatible with the handset, providing:

- connector for handset interface (LAN IF, power, optionally user interface)
- LAN physical interface
- optional extra LAN ports and hub (for connecting e.g. a computer)
- optional button to facilitate mode switching
- optional user interface: keypad, display, wired handset, headset, speakerphone

When in the docking station, the handset preferably communicates using the LAN interface. When out of the docking station, the handset uses the WLAN interface (or optionally the cellular interface). If a communication session is active and docking/undocking takes place, the handset will update the SDP info using SIP\_Invite or similar techniques to allow the session to continue on the new interface.

#### **PROBLEMS SOLVED BY THE INVENTION:**

As the penetration of mobile handset with WLAN capability increase, the coverage and capacity of WLAN networks will have to be carefully monitored and updated on a regular basis.

**WLAN**, being a wireless technology, is more susceptible to intermittent performance (coverage, interference, capacity) and has a reduced capacity compared to LAN.

In order to alleviate some of this pressure, a wired interface is added to the mobile handset so that if the user is currently in his office, the LAN interface will be used, providing a more stable and higher performance network connection while reducing the need for more WLAN capacity.

Solutions that have been tried and what they last

Deploying more WLAN APs: increased cost and potential co-channel interference from adjacent APs

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- When docked, the handset registers via SIP the LAN IP address as its primary contact
- When undocked, the WLAN IP address is registered
- For docking status change, the old contact is deleted
- For docking status change during an active session, the handset will send a new invite with the same callID, providing the new IP address to use
- The handset is configured to detect the presence of the docking station

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- A button on the docking station can be used (most useful during a call) to bring up the WLAN interface on and transfer the call on it before the handset is undocked, enabling a virtually hitless transition.

~~Commercial value of the innovation to Nortel and Nortel's major competitor(s)~~

High likelihood that future dual mode handsets will integrate this capability, especially for the business users.

# **Appendix B**

## Jennifer Alkove

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**From:** Jennifer Alkove  
**Sent:** Thursday, February 26, 2004 1:47 PM  
**To:** 'Dany Sylvain'  
**Subject:** RE: First Draft of (our file 7000-339)

I ended up having to re-send : since it eventually bounced. You should have three total from yesterday and today. Enjoy!

---

**From:** Dany Sylvain [mailto:[nortelnetworks.com](mailto:)]  
**Sent:** Thursday, February 26, 2004 1:45 PM  
**To:** Jennifer Alkove  
**Subject:** RE: First Draft of (our file 7000-339)

I got this second one.

...*Dany Sylvain*

-----Original Message-----

**From:** Jennifer Alkove [mailto:[jalkove@withrowterranova.com](mailto:jalkove@withrowterranova.com)]  
**Sent:** Wednesday, February 25, 2004 2:43 PM  
**To:** Sylvain, Dany [CAR:3A10:EXCH]  
**Cc:** Ben Withrow  
**Subject:** First Draft of (our file 7000-339)

Dany - I sent a draft of earlier today and got a "message still undelivered after 1 hour" error - let me know if you don't receive that email.

---

Dear Dany:

Please find attached a first draft of the above-referenced patent application. The .zip file is protected with the password that we have used in previous applications. If you have any problems opening the attached file, please let me know. Please review the application and drawings carefully for accuracy and completeness, making any changes, additions, or corrections, if any, directly on the application (or electronically with changes tracked).

Please recall that the application must clearly explain the best mode of practicing the invention for which protection is desired. Also, the application must explain to an individual of ordinary skill in the art how to make and use the invention. After reviewing the application, please forward any comments to Ben Withrow and me. We will then send you a revised draft of the application, along with formal paperwork prepared for your signature. After receipt of the signed paperwork and approval from Nortel's legal department, we will file the application.

Please do not hesitate to contact Ben Withrow or me should you have any questions regarding the application. Thank you for allowing us to be of service to you and for your prompt attention to this matter.

Best regards,

Jennifer Rush Alkove

Withrow & Terranova, PLLC

201 Shannon Oaks Circle, Suite 200

Cary, NC 27511

Ph: 919-654-4570 Fax: 919-654-4521

**WARNING!** This message may contain information that is confidential and/or protected under the attorney-client or other lawfully recognized privilege. If you received this message in error or through inappropriate means, please REPLY to this message to notify the Sender that the message erroneously was received by you, and then permanently delete this message from all storage media, without forwarding or retaining a copy.

No virus found in this outgoing message.

Checked by AVG Free Edition.

Version: 7.5.467 / Virus Database: 269.6.2/785 - Release Date: 5/2/2007 2:16 PM

# **Appendix C**

Nortel Case Status						
Matter ID	Nortel Ref	Date of Letter & Fax	First draft sent	First draft received back	Final draft sent (IP Law)	Final draft comments received back (IP Law)
7000-339	Handset With Wired And Wireless Network Interface	1/22/2004	2/25/2004	3/8/2004	3/16/2004	4/13/2004